



22 MAY 2008

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In re Application of  
BRIGHT  
Application Serial No.: 10/575,557  
PCT No.: PCT/GB04/04360  
Int. Filing Date: 15 October 2004  
Priority Date: 15 October 2003  
Atty Docket No.: 02838  
For: APPLICATOR

DECISION ON PETITION

UNDER 37 CFR 1.47(b)

This decision is in response to the "Petition For Submission of Declaration Under 37 CFR 1.47" filed 06 May 2008 in the United States Patent and Trademark Office (USPTO). As detailed below, the submission was initially filed 22 August 2007.

**BACKGROUND**

On 15 October 2004, applicant filed international application PCT/GB04/04360 which claimed priority to an earlier application filed 15 October 2003. A copy of the international application was transmitted to the United States by the International Bureau (IB) on 06 May 2005. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 15 April 2006.

On 12 April 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1). An executed oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed.

On 01 March 2007, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. In addition, applicant was notified of the need to provide a surcharge of \$130.00 for filing the oath or declaration later than the appropriate 20 or 30 months from the earliest priority date. (37 CFR 1.492(e)). Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 24 August 2007, applicant responded with a petition under 37 CFR 1.47(b), executed declaration and petition for a four-month extension of time.

On 01 February 2008, applicant was mailed a "Notification of Acceptance" (Form

PCT/DO/EO/903) indicating a completion of the 35 U.S.C. 371 requirements on 24 August 2007.

On 06 May 2008, applicant responded with the present petition.

### **DISCUSSION**

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(h); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant has satisfied items (1) and (3) through (6).

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature."

In the present case it appears that Mr. Bright was not sent a complete set of application papers, but merely a declaration and assignment documents. The letter from Mr. Baker to Mr. Bright lists the documents included for execution but does not indicate that a copy of the application is being included for the inventor's review. While Mr. Bright indicates in his response that he does not intent to "sell or assign the patent of my invention" the response does not identify the above identified application, as such it is unclear whether Mr. Bright knows to which invention the request to execute is directed. As a complete set of papers has not been mailed to the inventor prior to his response, it is not possible to consider his subsequent silence as a refusal for the purposes of 37 CFR 1.47.

In light of the above, it is not possible to grant applicant's petition at this time.

### **CONCLUSION**

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

The Form PCT/DO/EO/903 mailed 01 February 2008 is hereby **VACATED**.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'Derek A. Putonen', written in a cursive style.

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